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rejections based on 35 U.S.C. § 251. Applicant further appreciates the Examiner's indication in paragraph 10 that the Terminal Disclaimer has been reviewed, accepted, and recorded.

In response to paragraph 1, and in accordance with the continuing obligation under 37 C.F.R. § 1.56, Applicant submits that there is no currently pending litigation where U.S. Patent No. 5,842,685 ("the '685 patent") is directly involved. Regarding paragraph 2, Applicant hereby makes an offer to surrender the original patent before the allowance of this reissue application, in accordance with 37 C.F.R. 1.178.

In response to Examiner withdrawing Claims 23-25 from consideration as being directed to a non-elected invention in paragraph 3 of the Final Office Action, Applicant filed a divisional application on March 22, 2002 for the scope of the subject matter in Claims 23-25. Applicant canceled Claims 23-25 from this application without any comment on the patentability of the subject matter in Claims 23-25.

In response to Examiner's comments regarding inventorship in paragraph 4, the additional inventor was being added because of the addition of Claims 23-25. As mentioned before, Claims 23-25 have been cancelled. The additional inventor was not an inventor or co-inventor for the subject matter in Claims 1-22. Therefore, the comments of paragraph 4 are no longer applicable to this application.

#### **REJECTION BASED UPON RECAPTURE – 35 U.S.C. § 251**

In paragraph 6, the Examiner rejected claims 12-22 under 35 U.S.C. § 251 as being improper recapture of broadened subject matter surrendered in the application for the patent upon which the present reissue is based. Applicant respectfully disagrees with the Examiner that the broadening aspect relates to subject matter that Applicant previously surrendered during the prosecution because there is no reliable evidence that Applicant admitted that the scope of the subject matter in the cancelled/amended claims was not patentable. In fact, in paragraphs 11-12 of the March 3, 1997 Office Action during the prosecution of the '685 patent, the Examiner admitted that the scope of the subject matter in the claims that were later amended/canceled was patentable. Accordingly, because the attorney for Applicant amended/canceled claims when that was not the only means of getting the claims allowed was an error making the '685 patent wholly or partly inoperative or invalid by reason of the attorney for the Applicant claiming less than Applicant had a right to claim in the '685 patent.

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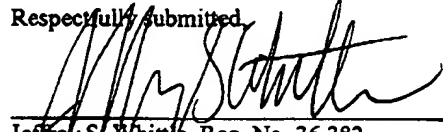
Absent a showing of an admission that the surrendered subject matter was unpatentable, the error by the attorney for the Applicant is correctable error under Section 251.

Furthermore, after the 1999 amendment to Section 103 (c), the 102(e)/103 provisional rejection would not be a proper rejection under current patent laws because one of the sources that were cited as prior art is now specifically excluded as permissible prior art. The reissue application was filed after the effective date of the amendment. Under In re Wadlinger, 496 F.2d 1200, 181 U.S.P.Q. 826 (CCPA 1974), and Ex parte Holt, 214 U.S.P.Q. 381 (Bd.Pat.App.&Int. 1982), the law at the time of the reissue is the law that is to be applied, instead of the law at the time of the prosecution of the original patent. Wadlinger, 496 F.2d at 1208-10; Holt, 214 U.S.P.Q. at 383-84, and at 385-86. The Examiner indicated that the claims in the original application that were amended, were of patentable subject matter but for the 102(e)/103 provisional rejection. Because the prior art cited against the claims in the prosecution of the original application is no longer permissible prior art under amended Section 103 (c), Applicant's claims 12-22 are in condition for allowance.

#### SUMMARY

In summary, for reasons detailed above, it is submitted that all claims now present in the application are allowable. Accordingly, allowance of all claims is submitted to be in order. Such action is respectfully requested. In the event that Examiner does not agree that this response places the rejected claims in condition for allowance, this response places the reissue application in condition for allowance pending a favorable finding from an appeal of the Section 251 rejection.

Respectfully submitted,



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